

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO. 10/628,437
ATTORNEY DOCKET NO. Q75422

REMARKS

Applicant thanks the Patent Office for acknowledging Applicant's claim to foreign priority, and for indicating that the certified copy of the priority document, Japanese Patent Application No. 2002-221560 dated July 30, 2002, has been made of record in the file.

Applicant thanks the Patent Office for initialing the references listed on the PTO/SB/08 A & B forms submitted with the Information Disclosure Statements filed on July 29, 2003 and December 9, 2003, respectively, and returning initialed copies of the PTO/SB/08 A & B, thereby confirming that the listed references have been considered.

The Patent Office objects to the specification as containing informalities. Applicant herein amends the specification to remove the informalities identified by the Patent Office. No new matter has been added to the specification.

Applicant herein amends the Abstract of the Disclosure to conform it to U.S. practice. No new matter has been added to the Abstract of the Disclosure.

The Patent Office objects to claim 4 as containing informalities. Applicant herein amends claim 4 to remove the informalities identified by the Patent Office, and respectfully requests withdrawal of same.

Claims 1-5 have been examined on their merits.

Applicants herein amend claims 1 and 4. No new matter has been added to claims 1 and 4. The amendments to claims 1 and 4 more accurately claim the present invention, do not narrow the literal scope of the claim, and thus, do not implicate an estoppel in the application of the doctrine of equivalents.

Applicant herein adds new claims 5-13. The new claims 5-13 are supported by the originally-filed specification, and do not add any new matter. Entry and consideration of the new claims is respectfully requested.

Claims 1-13 are all the claims presently pending in the application.

1. Claims 1-5 stand rejected under 35 U.S.C. § 112 (1st para.) as allegedly failing to comply with the written description requirement. Applicant traverses the rejection of claims 1-5, and insofar as the § 112 (1st para.) rejection might apply to new claims 6-13, for at least the reasons discussed below.

Original claims constitute their own description. *In re Koller*, 613 F.2d 819 (CCPA 1980); MPEP § 2163.03. The specification need not contain an example if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation. *In re Borkowski*, 422 F.2d 904, 908 (CCPA 1970). To satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date, the applicant was in possession of the invention. The test for sufficiency of support in an application is whether the disclosure relied upon “reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.” *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983)). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams and formulas that fully set

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forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

As recited at page 18, lines 3-17 in the instant application:

Other methods that can be employed are (c) controlling the degree of the emulsion's disruption before the start of printing such that it is first greater, then smaller than the degree of the emulsion's disruption after the start of printing and (d) controlling the degree of the emulsion's disruption before the start of printing such that it is first smaller, then greater than the degree of the emulsion's disruption after the start of printing. Specific versions of methods (c) and (d) are depicted in FIGs. 6 and 7, respectively.

In methods (c) and (d), too, the degree of the emulsion's disruption can be changed at multiple levels or continuously. This is effective in not only preventing the scumming of the lithographic printing plate but also improving ink build-up.

As noted above, original claims constitute their own description, and it is abundantly clear that claims 1-5 and Figures 6 and 7 contemplated changing the degree of the emulsion's disruption after a start of printing. Furthermore, the specification is replete with references to the changing of the degree of the emulsion's disruption after a start of printing. *See, e.g.*, page 13, lines 11-12, 19-20; page 19, lines 11-12; page 20, lines 4-5 of the instant specification. Thus, Applicant submits that the present invention fulfills the written description requirement under *Ralston* and *Lockwood*, and therefore respectfully requests that the Patent Office withdraw the 35 U.S.C. § 112 (1st para.) rejection of claims 1-5.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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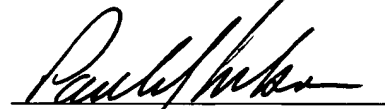
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